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VIDAS, ARRETT & STEINKRAUS, P.A. 6109 BLUE CIRCLE DRIVE SUITE 2000 MINNETONKA, MN 55343-9185			PIAZZA CORCORAN, GLADYS JOSEFINA	
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			1733	

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/990,109

Applicant(s)

BOUDOURIS ET AL.

Examiner

Gladys J Piazza Corcoran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19-42, 45-60, 72 and 75-80 is/are pending in the application.
- 4a) Of the above claim(s) 42 and 45-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17, 19-41, 60, 72 and 75-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/9, 6/10, 6/14.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 42, 45-59 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group II, there being no allowable generic or linking claim. Election was made **without** traverse in the Paper filed December 11, 2003.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: While the amendments to the claims 22-24 changing the units from μ to μm is not considered new matter as they are equivalent, Applicant must provide antecedent basis in the Specification to include the units μm and/or insertion into the Specification an indication that they are equivalent.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 9 is unclear by reciting that the magnetic assembly is formed in a roll form on a web. Is the magnetic assembly formed into a roll where the layers are in web form,

or is the assembly of the magnetic layer and the printable substrate layer formed in a roll and then placed on the web? It is suggested to amend the claim with claim language as provided in the original Specification.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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9. Claims 1-17, 22-32, 35, 38-41, 72, 75, 76 are rejected under 35 U.S.C. 103(a) as obvious over Bielek et al. (US Patent No. 6,387,485) in view of Silverschotz et al. (US Patent No. 5,869,148) as further taken with Wade (US Patent No. 3,470,055), Mueller (US Patent No. 2,690,206), and/or Yanulis (US Patent No. 2,944,586).

Bielek discloses a process of forming a magnetic assembly (composite substrate 10) by providing a magnetic composition at an elevated temperature (extrusion coated) comprising about 75% to 95% (column 2, lines 41-59) of at least one magnetic material and about 5% to 25% of at least one thermoplastic polymer (column 2, lines 41-59), directly applying the magnetic composition (14) at an elevated temperature when it is pliable to a printable substrate layer (12) (extrusion coated; column 3, lines 19-27).

As to the limitation that the magnetic composition is a hot melt, the binders in Bielek are considered to include hot melt binders. Alternatively, Silverschotz is cited to show that it is known that the binders in such magnetic compositions are considered to be hot melt polymers (column 3, line 22). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of forming a magnetic assembly as shown by Bielek with a composition that is a hot melt, as the compositions cited in Bielek are considered to be hot melts and additionally since it is known to provide such compositions with hot melt binders as exemplified by Silverschotz.

As to the magnetic composition being applied at an elevated temperature, Bielek is considered to meet this limitation by disclosing the magnetic composition is applied by extrusion coating (column 3, lines 19-27). Optionally, the references Wade, Mueller, Yanulis are cited to show that it is conventionally known in that art that extrusion coated

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polymeric layers are applied at elevated temperatures. It would have been obvious to one of ordinary skill in the art at the time of the invention to form the magnetic assembly as shown by Bielek by providing the magnetic composition at an elevated temperature as is conventionally known for extrusion coating of polymeric materials and as optionally further exemplified by Wade, Mueller, Yanulis.

As to claims 2 and 3, the extrusion coating of the magnetic composition layer on the printable substrate layer (12) in dimensions of thickness and width and length. As to claim 4, the magnetic assembly is subjected to a strong magnetic field sufficient to result in a permanent magnetic effect in the assembly (column 4, lines 1-5). As to claim 5, Bielek does not specifically disclose whether the assembly is at an elevated temperature while being subjected to the magnetic field, however, it is considered well known in the art to apply the magnetic field while the composition is at an elevated temperature and it would have been obvious to one of ordinary skill in the art to form the magnetic assembly in Bielek in such a conventional manner. As to claim 6, the magnetic assembly is at ambient temperature after it is produced. As to claim 7, the magnetizing step is accomplished after the applying step (column 4, lines 1-5). As to claim 8, the printable substrate is printed (column 2, lines 29-31; column 3, lines 24-27).

As to claim 9, Bielek does not specifically disclose the particular method steps after formation. However, it is considered well known in the art to form extrusion coated layers into a roll form after coating. For example, Wade, Mueller, and Yanulis all show examples in the art of extrusion coating polymeric layers onto substrate layers in web form and then rolling into a roll. It would have been obvious to one of ordinary skill in

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the art at the time of the invention to provide the magnetic assembly as shown in Bielek by rolling the coated layers into a roll form after extrusion coating as is considered conventional in the art and further exemplified by Wade, Mueller, and Yanulis.

As to claim 10, Bielek discloses finished products in sheet form and it would have been well within the purview of one of ordinary skill in the art to form the magnetic assembly into a sheet form, only the expected results would be attained.

As to claims 11, 12, 75, 76, it is considered well known in the packaging arts to packaged groups items such as novelty items as disclosed by Bielek by stacking the items into a pad and binding by either adhesive or shrink wrap. Only the expected results would be attained by employing such a well known and conventional packaging practice to the novelty items in Bielek for distribution.

As to claim 13, Bielek does not disclose the particular temperature at which the coating is extrusion coated, however, selecting the appropriate temperature is considered well within the purview of one of ordinary skill in the art and is only dependent upon the particular materials used, speed, thickness, etc. Furthermore, Yanulis shows it is known to extrude polymeric materials in the same temperature range as claimed (column 3, lines 1-5). It would have been obvious to one of ordinary skill in the art at the time of the invention to form the magnetic assembly in Bielek by selecting the appropriate temperature of application in accordance with the materials selected as would have been well within the purview of one of ordinary skill in the art and is considered within the known ranges as exemplified by Yanulis.

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As to claim 14, Bielek discloses extrusion coating as one example of coating the magnetic composition to the printable layer, however roll coating, gravure coating, screen printing, and slot-die coating are considered well known equivalent alternative coating methods in the art. For example, Silverschotz discloses coating magnetic materials in the alternative forms (column 3, lines 59-63). It would have been obvious to one of ordinary skill in the art at the time of the invention to form the magnetic assembly as shown by Bielek by well known and conventional coating application methods as are considered equivalent methods in the art to extrusion coating as exemplified by Silverschotz.

As to claim 15, Bielek discloses extrusion coating. As to claim 16, Bielek discloses using a ferrite as the magnetic material (column 2, lines 41-47). As to claim 17, these materials are considered conventional magnetic particles and well known in the art and it would have been well within the purview of one of ordinary skill in the art at the time of the invention to select any of the well known magnetic materials, only the expected results would be attained. As to claim 21, Bielek discloses the particular particle size (column 2, line 47). As to claims 22-24, Bielek discloses the particular coating thickness of the magnetic layer (column 3, lines 5-7). As to claims 25 and 28, the extrusion coated layer in Bielek is considered to be in the form of a ribbon with substantially the same width and length as the printable substrate layer. As to claims 26 and 27, it is considered conventional to press the extrusion coated layer to the substrate with a chill roll as exemplified by Wade, Mueller and/or Yanulis.

As to claims 29 and 40, Silverschotz discloses it is known in the art to apply magnetic compositions onto printable substrates in a discontinuous pattern (see figure 4 for example) in order to form a variety of different end products. It would have been obvious to one of ordinary skill in the art at the time of the invention to form the magnetic assemblies as shown by Bielek by applying the magnetic composition in a discontinuous pattern in order to form a variety of end products as shown by Silverschotz.

As to claim 30, Bielek discloses the printable substrate layer is plastic. Additionally, it is considered well known in the art to coat magnetic layers onto printable substrate layers made of a variety of materials including paper, metal, fabric, or plastic as exemplified by Silverschotz (column 2, line 63). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the magnetic assembly as shown by Bielek with a printable substrate layer made of paper, metal or fabric as well known alternatives to plastic as exemplified by Silverschotz.

As to claim 31, Bielek discloses treating the printable layer with a variety of well known coatings (column 2, lines 21-41). It is further noted that Silverchotz also discloses it is known in the art to treat the printable layer (column 3, lines 1-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to form the magnetic assembly as shown by Bielek by treating the printable substrate layer as is considered well known in the art and further exemplified by Silverschotz.

As to claims 32 and 35, Bielek discloses joining the magnetic layer to a release liner (18) and the step of removing the magnetic assembly from the release liner

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(column 3, lines 27-37). As to claim 38, Bielek discloses providing the magnetic composite as a variety of known novelty items. It is considered well known in the art that items such as reminders, business cards, greeting cards, postcards, labels, advertisements, coupons, calendars, schedules, recipes, or promotional cards are considered novelty items in the art. Additionally, Silverchotz discloses magnetic assemblies of the claimed articles (column 7, line 49 to column 8, line 5). It would have been obvious to one of ordinary skill in the art at the time of the invention to form the magnetic assembly as shown in Bielek into novelty items such as those claimed as is considered well known in the art and further exemplified by Silverschotz.

As to claims 39 and 41, the magnetic layer in Bielek is continuous with the printable layer and the magnetic layer and printable layer are of equivalent length and width. As to claim 72, all the limitations have been addressed with reference to claim 1 above.

10. Claims 1-10, 13-17, 22-32, 35, 38-41, 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bielek et al. (US Patent No. 6,387,485) in view of Silverschotz et al. (US Patent No. 5,869,148) as further taken with Wade (US Patent No. 3,470,055), Mueller (US Patent No. 2,690,206), and/or Yanulis (US Patent No. 2,944,586) as applied to the claims above, and further in view of Marshall et al. (US Patent No. 5,503,891).

As to the claimed percentages of the magnetic composition, Bielek appears to disclose at least up to 90% magnetic particles. It is known in the art to provide at least up to 96% magnetic particles in magnetic compositions in order to provide a stronger

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magnetic force. For example, Marshall discloses an example of a magnetic assembly where the magnetic composition layer comprises between 60 and 96% magnetic particles (column 2, lines 15-20). It would have been obvious to one of ordinary skill in the art at the time of the invention to form the magnetic assembly in Bielek with known percentages in the art of magnetic particles in the magnetic composition in order to provide the desired amount of magnetic strength in the finished product as exemplified by Marshall, only the expected results would be attained.

11. Claims 5 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bielek et al. (US Patent No. 6,387,485) in view of Silverschotz et al. (US Patent No. 5,869,148) as further taken with Wade (US Patent No. 3,470,055), Mueller (US Patent No. 2,690,206), and/or Yanulis (US Patent No. 2,944,586) and optionally further in view of Marshall et al. (US Patent No. 5,503,891) as applied to claim 1 above, and further in view of Ripplingale et al. (US Patent No. 5,114,517).

As to claim 77, the limitations similar to claim 1 are rejected as discussed above with reference to claim 1. As to claims 5 and 77, Bielek discloses subjecting the extruded layer to a magnetic field, but does not disclose if this is done while the extruded layer is still at an elevated temperature. Ripplingale discloses subjecting an extruded magnetic layer to a magnetic field in order to provide a magnetic effect in the assembly (column 3, lines 10-28). The magnetic assembly is subjected to a magnetic field while the magnetic composition is at an elevated temperature in order to allow the proper alignment of the magnetic particles while the material is still soft (column 3, line 20). It would have been obvious to one of ordinary skill in the art at the time of the

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invention to provide the method of forming a magnetic assembly as shown by Bielek by subjecting the assembly to a magnetic field while the extruded layer is at an elevated temperature in order to provide a magnetic effect in the assembly while the magnetic particles can still be aligned as shown by Rippingale.

12. Claims 17, 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bielek et al. (US Patent No. 6,387,485) in view of Silverschotz et al. (US Patent No. 5,869,148) as further taken with Wade (US Patent No. 3,470,055), Mueller (US Patent No. 2,690,206), and/or Yanulis (US Patent No. 2,944,586) and optionally further in view of Marshall et al. (US Patent No. 5,503,891) as applied to claim 1 above, and further in view of Sawa (US Patent No. 4,022,701).

As to claim 17, Bielek discloses a variety of materials for the magnetic particles including ferrite. It is considered well known in the art to provide a variety of well known magnetic ferrite compositions for magnetic particles such as barium, strontium, or lead in thermoplastic binders as exemplified by Sawa (column 3, lines 8-15). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the magnetic assembly as shown in Bielek with well known magnetic particles for the magnetic composition as exemplified by Sawa, only the expected results would be attained.

As to claims 19 and 20, Bielek discloses a variety of polyolefins for use as the thermoplastic binder. While Bielek does not specifically disclose using a polyalphaolefin, such thermoplastic binders are considered well known and one of ordinary skill in the art would readily recognize using such compositions, only the

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expected results would be attained. For example, Sawa discloses the use of known polyalphaolefins as a binder for magnetic compositions. It is noted that applicant admits in the Specification on page 7 that it is common for the terms polyolefin and polyalphaolefin to be used interchangeably. It would have been obvious to one of ordinary skill in the art at the time of the invention to form the magnetic assembly as shown by Bielek with known thermoplastic polymers such as polyalphaolefins as is considered well known in the art and further exemplified by Sawa, only the expected results would be attained.

As to claim 21, Sawa discloses it is known in the art to provide magnetic particles of a size less than 40 microns (column 2, lines 40-45). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the magnetic assembly as shown in Bielek with a known particle size for the magnetic particles in the magnetic composition as exemplified by Sawa, only the expected results would be attained.

13. Claims 33, 34, 36, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bielek et al. (US Patent No. 6,387,485) in view of Silverschotz et al. (US Patent No. 5,869,148) as further taken with Wade (US Patent No. 3,470,055), Mueller (US Patent No. 2,690,206), and/or Yanulis (US Patent No. 2,944,586) and optionally further in view of Marshall et al. (US Patent No. 5,503,891) as applied to claim 1 above, and further in view of Charley (US Patent No. 6,153,279).

Bielek shows a method of forming a magnetic assembly for forming novelty items including a release layer as discussed above.

As to claims 33 and 34, it is considered well known in the art to adhere assemblies with release liners to articles such as magazines, books, food packages, beverage containers, envelopes or boxes. For example, Charley discloses it is known in the art to form magnetic assemblies with release layers where the assembly is adhered to an article with the use of an adhesive in order to provide such known novelty items to known articles such as boxes. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the release layer in the magnetic assembly of Bielek with adhesive to adhere to a well known article in order to provide the assembly to consumers as is considered well known in the art and further exemplified by Charley.

As to claims 36 and 37 it is considered well known in the art to provide a perforated overlamine over magnetic assemblies in order to protect the assemblies until the consumer removes the assembly from the article. For example, Charley discloses a magnetic assembly with a perforated overlamine (18; column 3, lines 5-21). It would have been obvious to one of ordinary skill in the art at the time of the invention to form the magnetic assembly as shown in Bielek with a perforated overlamine in order to protect the assembly until the consumer removes it from an article as shown by Charley.

14. Claim 60 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bielek et al. (US Patent No. 6,387,485) as taken with Wade (US Patent No. 3,470,055), Mueller (US Patent No. 2,690,206), and/or Yanulis (US Patent No. 2,944,586).

Bielek discloses a process of forming a magnetic assembly (composite substrate 10) by extruding at an elevated temperature (extrusion coated) a magnetic composition (14) comprising about 70% to 95% (column 2, lines 41-59) of at least one magnetic material and about 5% to 30% of at least one thermoplastic polymer (column 2, lines 41-59), onto a printable substrate layer (12) (extrusion coated; column 3, lines 19-27).

As to the magnetic composition being applied at an elevated temperature, Bielek is considered to meet this limitation by disclosing the magnetic composition is applied by extrusion coating (column 3, lines 19-27). Optionally, the references Wade, Mueller, Yanulis are cited to show that it is conventionally known in that art that extrusion coated polymeric layers are applied at elevated temperatures. It would have been obvious to one of ordinary skill in the art at the time of the invention to form the magnetic assembly as shown by Bielek by providing the magnetic composition at an elevated temperature as is conventionally known for extrusion coating of polymeric materials and as optionally further exemplified by Wade, Mueller, Yanulis.

As to the particular thermoplastic polymers, Bielek discloses providing a variety of thermoplastic polymers polyolefins. As to the alternative polymers of natural rubbers, block copolymers, and polyalphaolefins, such are considered well known polymers in the art for providing flexible binder extrusions and it would have been well within the purview of one of ordinary skill in the art at the time of the invention to provide any one of the claimed polymers known in the art, only the expected results would be attained.

15. Claims 60 and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bielek et al. (US Patent No. 6,387,485) as taken with Wade (US Patent No.

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3,470,055), Mueller (US Patent No. 2,690,206), and/or Yanulis (US Patent No. 2,944,586) as applied to claim 60 above, and further in view of Marshall et al. (US Patent No. 5,503,891).

As to the claimed percentages of the magnetic composition, Bielek appears to disclose at least up to 90% magnetic particles. It is known in the art to provide at least up to 96% magnetic particles in magnetic compositions in order to provide a stronger magnetic force. For example, Marshall discloses an example of a magnetic assembly where the magnetic composition layer comprises between 60 and 96% magnetic particles (column 2, lines 15-20). It would have been obvious to one of ordinary skill in the art at the time of the invention to form the magnetic assembly in Bielek with known percentages in the art of magnetic particles in the magnetic composition in order to provide the desired amount of magnetic strength in the finished product as exemplified by Marshall, only the expected results would be attained.

As to claim 78, Bielek discloses a variety of known polymers for the magnetic composition. Marshall discloses it is known in the art to use an ethylene vinyl acetate copolymer as the binder in a magnetic assembly. It would have been obvious to one of ordinary skill in the art at the time of the invention to form the magnetic assembly in Bielek with known thermoplastic polymers as the binder as exemplified by Marshall, only the expected results would be attained.

16. Claims 79 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bielek et al. (US Patent No. 6,387,485) in view of Silverschotz et al. (US Patent No. 5,869,148) as further taken with Wade (US Patent No. 3,470,055), Mueller (US

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Patent No. 2,690,206), and/or Yanulis (US Patent No. 2,944,586) and optionally further in view of Marshall et al. (US Patent No. 5,503,891) as applied to claim 1 above, and further in view of Gregory (US Patent No. 4,941,935), Christel (US Patent No. 5,676,791), and/or Thompson (US Patent No. 4,455,184).

Bielek does not specifically disclose the particular rate in which the magnetic layer is applied to the printable substrate layer. However, it would have been well within the purview of one of ordinary skill in the art to select the appropriate rate for the particular materials used, the end product requirements of thickness and adhesion, etc. Additionally, Gregory, Christel, and/or Thompson are cited to show that the claimed ranges of application rates are known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to form the magnetic assembly as shown by Bielek with an appropriate application rate as is considered well within the purview of one of ordinary skill in the art to select and as further shown by Gregory, Christel, and/or Thompson as being within the known ranges, only the expected results would be attained.

17. Claim 77 is rejected under 35 U.S.C. 103(a) as being unpatentable over Silverchotz et al. (US Patent No. 5,869,148) further in view of Rippingale et al. (US Patent No. 5,114,517).

Silverchotz discloses a process of forming a magnetic assembly by providing a magnetic composition (601) at an elevated temperature comprising at least one magnetic material and at least one thermoplastic polymer (column 2, lines 19-27; using a hot melt polymer; column 3, line 22), and directly applying the magnetic layer at an

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elevated temperature when it is pliable to a printable substrate layer (web 200) (the hot melt composition is coated onto the substrate layer). Silverchotz discloses the composition comprising 70% magnetic material and 30% polymer (column 3, lines 25-30)

Silverchotz discloses subjecting the extruded layer to a magnetic field, but does not disclose if this is done while the extruded layer is still at an elevated temperature.

Rippingale discloses subjecting an extruded magnetic layer to a magnetic field in order to provide a magnetic effect in the assembly (column 3, lines 10-28). The magnetic assembly is subjected to a magnetic field while the magnetic composition is at an elevated temperature in order to allow the proper alignment of the magnetic particles while the material is still soft (column 3, line 20). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of forming a magnetic assembly as shown by Silverchotz by subjecting the assembly to a magnetic field while the extruded layer is at an elevated temperature in order to provide a magnetic effect in the assembly while the magnetic particles can still be aligned as shown by Rippingale.

Double Patenting

18. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

19. Claims 1 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 9, 12, 14, 15, 27 of copending Application No. 10/274189. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in 10/274189 fully encompass the claim limitations of the instant application. As to whether the magnetic composition is a hot melt in claims 1, 72, 75 such would have been well within the purview of one of ordinary skill in the art particularly in view of the references cited above. As to the limitations in claims 2-17, 19-41, 60, 75-80, of the instant Application, these limitations would have been obvious in view of the references as cited above as known in the art, only the expected results would be attained.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Amendment

20. The declaration under 37 CFR 1.132 filed June 10, 2004 is insufficient to overcome the rejection of claim 77 based upon Silverschotz et al. (US Patent No. 5,869,148) as set forth in the last Office action nor the current rejections in light of all the evidence on the record as a whole. There is no nexus or relevance between the statements in the declaration and the issue of obviousness. The declaration does not provide any factual evidence or actual proof of statements. The declaration appears to

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only be opinions of a co-inventor of the instant application. The attached letters to the declaration are not in declaration form, one letter is not even signed, and are only letters of opinion of parties which have an interest in the instant Application.

For example, paragraph 5c of the declaration asserts that providing direct application of a ferrite/thermoplastic polymer mixture onto a paper substrate removes the necessity of first manufacturing a magnet, and then adhering the magnet to a substrate and that this is a technological advance in the art. (It is noted that the claim is not limited to paper substrates). However, the reference Silverschotz and newly cited Bielek both disclose direct application of a ferrite/thermoplastic polymer mixture to a printable substrate; the statement in the declaration is not the issue of obviousness in the rejections.

The declaration paragraph 5h argues that the statements in the attached letter A provides objective indicia of the commercial success and the failure of others. As to the commercial success, as stated above, there is no actual evidence of commercial success. Additionally, the declaration does not show that factual evidence of commercial success is commensurate in scope with the claims or that the commercial success was derived from the claimed invention (see MPEP § 716, 716.03). As to the failure of others, as stated above, there is no actual evidence of failure of others. Additionally there is no evidence that the art recognized the problem existed in the art for a long period of time without solution (see MPEP § 716, 716.04).

As to the paragraphs 6 and 7, these refer to letters that are related to opinions only and not factual evidence.

Response to Arguments

21. Applicant's arguments filed June 10, 2004 have been fully considered but they are not persuasive.

It is noted that amendments to some of the claims have successfully overcome some of the prior rejections based on Silverschotz, however the claims are still all currently rejected based on Bielek or Silverschotz.

Applicant argues on pages 9-11 the substance of the declaration and the attached letters. As indicated above, there is no factual evidence of the commercial success, failure of others, or industry respect sufficient to overcome the references. In addition, there is no nexus between the information asserted and the current claims and reasons for obviousness.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gladys J Piazza Corcoran whose telephone number is (571) 272-1214. The examiner can normally be reached on M-F 8am-5:30pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571) 272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gladys J. Corcoran
Primary Examiner
Art Unit 1733

GJPC